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140	7590	08/26/2005	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			HENNING, MATTHEW T	
			ART UNIT	PAPER NUMBER
			2131	
DATE MAILED: 08/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,297

Applicant(s)

SHEN-ORR ET AL.

Examiner

Matthew T. Henning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-122, 124-140 and 153-165 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-122, 124-140 and 153-165 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/9/04, 7/23/04, 12/18/01, 8/27/01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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This action is in response to the communication filed on 6/17/2005.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Claims 84-122, 124-140, and 153-165 in the reply filed on 6/17/2005 is acknowledged.

Claims 123, and 141-152 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/17/2005.

Claims 84-122, 124-140, and 153-165 have been examined and claims 1-83, 123, and 141-152 have been cancelled.

Title

The title of the invention is acceptable.

Priority

This application is a 371 of PCT/IL01/00013 filed 1/4/2001 which is a CIP of provisional application 60/174,530 filed 1/5/2000.

Therefore, the effective filing date for the subject matter defined in the pending claims in this application is 1/5/2000.

Information Disclosure Statement

The information disclosure statement(s) (IDS) submitted on 9/9/04, 7/23/04, 12/18/01, and 8/27/01 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Drawings

Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

Applicant is advised that should claim 90 be found allowable, claim 91 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 84-104, 122, and 136-138 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 84 recites "an end user device" in line 2, "the end user device" in line 4, and "a first end user device" and "a second end user device" in lines 5-6. As such, the ordinary person

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1 skilled in the art would be unable to determine whether the first and second end user devices
2 were meant to be different than "the end user device". As such, the ordinary person skilled in the
3 art would be unable to determine the scope of the claim, and therefore claim 84 is rejected for
4 failing to particularly point out and distinctly claim the subject matter which the applicant
5 regards as the invention.

6 Claims 85-104 are rejected by virtue of their dependence to claim 84.

7 Claims 102-103, 136 and 137 recite the limitation "said period" in line 1. There is
8 insufficient antecedent basis for this limitation in the claims.

9 Claim 122 recites the limitation "said slots". There is insufficient antecedent basis for
10 this limitation in the claim.

11 Claim 138 recites the limitation "said group". There is insufficient antecedent basis for
12 this limitation in the claim.

13 *Claim Rejections - 35 USC § 102*

14 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
15 basis for the rejections under this section made in this Office action:

16 *A person shall be entitled to a patent unless –*

17 *(b) the invention was patented or described in a printed publication in this or a foreign*
18 *country or in public use or on sale in this country, more than one year prior to the date of*
19 *application for patent in the United States.*

20
21 *(e) the invention was described in (1) an application for patent, published under section*
22 *122(b), by another filed in the United States before the invention by the applicant for patent or*
23 *(2) a patent granted on an application for patent by another filed in the United States before the*
24 *invention by the applicant for patent, except that an international application filed under the*
25 *treaty defined in section 351(a) shall have the effects for purposes of this subsection of an*
26 *application filed in the United States only if the international application designated the United*
27 *States and was published under Article 21(2) of such treaty in the English language.*
28

1 Claims 84-88, 90-108, 110-122, 124-140, 155-156, and 158-165, are rejected under 35
2 U.S.C. 102(e) as being anticipated by Saito et al. (US Patent Number 6,069,952) hereinafter
3 referred to as Saito.

4 Regarding claim 84, Saito disclosed a method for flexible and secure transmission of
5 digital content to an end user device (See Saito Abstract), the method comprising: providing a
6 control center (See Saito Fig. 1 Element 10) for controlling access to the digital content by the
7 end user device (See Saito Col. 4 Lines 24-36); transmitting scrambled digital content to a first
8 end user device (See Saito Fig. 1 Element 5) by a second end user device (See Saito Fig. 1
9 Element 4) (See Saito Col. 5 Line 66 – Col. 6 Line 30), such that said second end user device
10 cannot play back said scrambled digital content (See Saito Col. 5 Line 66 – Col. 6 Line 17);
11 connecting said second end user device to said control center (See Saito Col. 6 Lines 11-17); and
12 transmitting a permission message to said second end user device by said control center, such
13 that said second end user device is able to unscramble said scrambled digital content to form
14 unscrambled digital content (See Saito Col. 6 Lines 18-24).

15 Regarding claim 105, Saito disclosed a method for securing digital content for
16 transmission to an end user device (See Saito Abstract), comprising: providing a control center
17 (See Saito Fig. 1 Element 10) for controlling access to the digital content by the end user device
18 (See Saito Col. 4 Lines 24-36); transmitting scrambled digital content to the end user device,
19 such that the end user device cannot play back said scrambled digital content (See Saito Col. 6
20 Lines 11-30); transmitting a PECM (personal ECM) to the end user device by said control center,
21 said PECM being specific to the end user device (See Saito Col. 6 Lines 31-56); and

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1 unscrambling said scrambled digital content by the end user device according to said PECM (See
2 Saito Col. 6 Lines 57-63).

3 Regarding claim 113, Saito disclosed a system for securing digital content for
4 transmission (See Saito Abstract), comprising: (a) an end user device for receiving scrambled
5 digital content and for unscrambling said scrambled digital content for playing back the digital
6 content (See Saito Col. 4 Lines 24-36); (b) a broadcast unit for transmitting said scrambled
7 digital content to said end user device (See Saito Col. 6 Lines 11-30); (c) a permission message
8 generator (See Saito Fig. 1 Element 10) for generating a permission message for transmission to
9 said end user device, such that said end user device unscrambles said scrambled digital content
10 only after said permission message is at least received by said end user device, said permission
11 message being specific for said end user device (See Saito Col. 6 Lines 39-56); and (d) a
12 subscription management system for controlling said permission message generator to determine
13 whether said permission message is generated (See Saito Col. 6 Lines 49-56).

14 Regarding claim 124, Saito disclosed a method for secure distribution of digital content
15 between end user devices (See Saito Abstract), comprising: receiving scrambled digital content
16 by a first end user device (See Saito Col. 4 Line 62 – Col. 5 Line 5); receiving a permission
17 message for unscrambling said scrambled digital content by said first end user device (See Saito
18 Col. 5 Lines 20-34); transferring said scrambled digital content directly from said first end user
19 device to a second end user device (See Saito Col. 6 Lines 25-30); and unscrambling said
20 scrambled digital content by said second end user device only after said permission message is
21 activated for said second end user device (See Saito Col. 6 Lines 57-63).

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1 Regarding claim 155, Saito disclosed a method for securing digital content for
2 transmission to a plurality of end user devices, said plurality of end user devices being members
3 of a group (See Saito Abstract), the method comprising: transmitting scrambled digital content to
4 a first end user device, such that said first end user device cannot play back said scrambled
5 digital content (See Saito Col. 4 Line 62 – Col. 5 Line 5); transmitting a PECM (personal ECM)
6 to said first end user device, said PECM being specific to the group of end user devices (See
7 Saito Col. 6 Lines 11-24); transmitting said scrambled digital content from said first end user
8 device to a second end user device, such that said second end user device cannot play back said
9 scrambled digital content (See Saito Col. 6 Lines 25-30); transmitting said PECM (personal
10 ECM) to said second end user device (See Saito Col. 6 Lines 39-56); and unscrambling said
11 scrambled digital content by said first and said second end user devices according to said PECM
12 (See Saito Col. 6 Lines 18-24 and 57-62).

13 Regarding claims 85, 106, and 116, Saito disclosed transmitting a first set of information
14 for decoding said scrambled digital content to said second end user device (See Saito Col. 4
15 Lines 62-67 and Col. 6 Lines 31-38); and permitting said second end user device to access said
16 first set of information only if said permission message is given to said second end user device
17 (See Saito Col. 6 Lines 31-63).

18 Regarding claim 86, Saito disclosed that the first set of information is distributed with
19 said scrambled digital content (See Saito Col. 6 Lines 31-38).

20 Regarding claims 87, 107, and 156, Saito disclosed that the first set of information is
21 distributed by said control center (See Saito Col. 6 Lines 39-56).

1 Regarding claim 88, Saito disclosed transmitting said scrambled digital content includes
2 contacting said control center by said second end user device to receive said permission message
3 (See Saito Col. 5 Lines 20-34).

4 Regarding claims 90-91, and 110, Saito disclosed that the first set of information enables
5 said unscrambled digital content to be permanently stored by said second end user device (See
6 Saito Col. 5 Lines 35-47).

7 Regarding claim 92, and 126, Saito disclosed that said first and said second end user
8 devices belong to a group of a plurality of end user devices (See Saito Fig. 1), such that said
9 permission message is sent to each end user device belonging to said group (See Saito Fig. 1 and
10 Col. 4 Lines 36-56 especially “one-dot chain line).

11 Regarding claim 93, and 127, Saito disclosed the membership in said group is at least
12 partially determined according to communication between said end user devices (See Saito Col.
13 6 Lines 25-48).

14 Regarding claims 94, and 128, Saito disclosed that transmitting said permission message
15 further comprises transmitting a token from said first end user device to said second end user
16 device, for including said first and second end user devices in the group (See Saito Col. 6 Lines
17 31-38).

18 Regarding claims 95, 129, and 158, Saito disclosed that transmitting said token is
19 performed repeatedly for the plurality of end user devices in the group until a limit is reached
20 (See Saito Col. 14 Lines 13-16).

21 Regarding claims 96, 130, and 159, Saito disclosed that if said number of end user
22 devices exceeds a maximum permitted number, transmitting said scrambled digital content and

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transmitting said permission message are not performed for an additional end user device (See Saito Col. 14 Lines 13-16 and Col. 6 Lines 49-56).

Regarding claims 97, 131, and 160, Saito disclosed that the limit is determined according to at least one reasonableness rule (See Saito Col. 14 Lines 13-16).

Regarding claims 98, 132, and 161, Saito disclosed that the limit is determined according to at least one reasonableness rule and wherein said at least one reasonableness rule restricts a number of copies of said scrambled digital content operable with said token (See Saito Col. 6 Lines 9-10 and 49-56, and Col. 14 Lines 13-16).

Regarding claims 99, 133, and 162, Saito disclosed that when the limit is reached, at least one of transmitting said scrambled digital content and transmitting said permission message is not performed (See Saito Col. 6 Lines 9-10 and 49-56).

Regarding claims 100, 134, and 163, Saito disclosed that at least one reasonableness rule requires at least said first end user device to wait for a predetermined period before transferring said scrambled digital content to an additional end user device in the group (See Saito Col. 5 Line 66 - Col. 6 Line 17).

Regarding claims 101, and 135, Saito disclosed that the wait period was greater for a second user than a first user (See Saito Col. 6 Line 11 – Col. 7 Line 31).

Regarding claims 102-103, 136-137, and 164-165, Saito disclosed that the period was at partially determined according to a period of time and operation a minimum number of times (See Saito Col. 5 Line 66 – Col. 6 Line 62).

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1 Regarding claim 125, Saito disclosed that at least said second end user device is in
2 communication with a control center and said permission message is activated for said second
3 end user device by said control center (See Saito Col. 6 Lines 39-56).

4 Regarding claims 104, and 138, Saito disclosed that membership in said group is at least
5 partially determined according to said control center, such that if said group has more than a
6 predetermined number of end user devices as members, said control center blocks receipt of said
7 permission message by members of said group (See Saito Col. 6 Lines 9-10 and 49-56, and Col.
8 14 Lines 13-16).

9 Regarding claim 108, Saito disclosed replacing the ECM with the PECM for
10 unscrambling said scrambled digital content by the end user device (See Saito Col. 6 Lines 57-62
11 and Col. 7 Lines 17-27).

12 Regarding claim 111, Saito disclosed sending the ECM from a first end user device to a
13 second end user device (See Saito Col. 6 Lines 31-38), receiving a specific PECM by said
14 second end user device from said control center (See Saito Col. 6 Lines 39-56), and
15 unscrambling said scrambled digital content by said second end user device only after receiving
16 said specific PECM (See Saito Col. 6 Lines 57-63).

17 Regarding claims 112, and 139, Saito disclosed that receiving said specific PECM by
18 said second end user device includes: transmitting payment to said control center (See Saito Col.
19 37 Embodiment 16), transmitting said PECM by said control center only after receiving payment
20 (See Saito Col. 6 Lines 39-56).

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1 Regarding claim 114, Saito disclosed a network for connecting said end user device, said
2 broadcast unit, said permission message generator and said subscription management system
3 (See Saito Fig. 1 Element 8).

4 Regarding claim 115, Saito disclosed that said permission message generator sends said
5 permission message to said subscription management system, and said subscription management
6 system transmits said permission message to said end user device (See Saito Col. 6 Lines 39-56
7 and Col. 14 Lines 54-56).

8 Regarding claim 117, Saito disclosed that said end user device further comprises a
9 security module for receiving said ECM and said PECM, and for unscrambling said scrambled
10 digital content for playing back the digital content upon receipt of at least one of said ECM and
11 said PECM (See Saito Col. 6 Lines 39-63).

12 Regarding claims 118-119, and 122, Saito disclosed that said security module further
13 comprises a renewable security submodule, said renewable security submodule being removable
14 and replaceable (See Saito Col. 38 Lines 31-43), wherein said renewable security submodule
15 comprises a smartcard (See Saito Col. 38 lines 3-12), and a smartcard reader for reading said
16 smartcard, said smartcard reader being separate from said end user device, such that data
17 produced by said smartcard is readable by said smartcard reader, including data resulting from
18 said slots, said data being readable as a coded reply (See Saito Col. 38 Lines 3-43).

19 Regarding claims 120-121, Saito disclosed that said security module features a limited
20 number of slots for being associated with a plurality of ECMS, such that if said limited number
21 of slots are used, a PECM corresponding to at least one stored ECM must be received before an
22 additional ECM is received by said end user device (See Saito Col. 38 Lines 31-43), wherein

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1 information concerning said slots is stored on said security module (See Saito Col. 38 Lines 52-
2 65).

3 Regarding claim 140, Saito disclosed that said permission message is operative only by
4 said first end user device, such that if said permission message is transferred to said second end
5 user device by said first end user device, said permission message cannot be used by said second
6 end user device (See Saito Col. 7 Lines 6-16).

7 Regarding claim 157, Saito disclosed sending the PECM from the first device to the
8 second device (See Saito Col. 6 Lines 31-38).

9 Claims 153-154 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuria (EP
10 0858184).

11 Tsuria disclosed in a system for secure distribution of digital content, the system
12 comprising a control center for distributing at least one key for unscrambling scrambled digital
13 content and an end user device for receiving the scrambled digital content, a method for
14 providing temporary access to received scrambled digital content, the method comprising:
15 sending a temporary key from the control center to the end user device, said temporary key being
16 valid for a limited period of time (See Tsuria Col. 9 Lines 6-15); receiving the scrambled digital
17 content by the end user device (See Tsuria Col. 8 Line 49 – Col. 9 Line 5); and unscrambling the
18 scrambled digital content by the end user device according to said temporary key, such that the
19 end user device is only permitted to unscramble the scrambled digital content while said
20 temporary key is valid (See Tsuria Col. 9 Line 43-55 and Col. 2 Line 57 – Col. 3 Line 20) and
21 receiving a permanent key by the end user device from the control center (See Tsuria Col. 9
22 Lines 43-55); replacing said temporary key with said permanent key (See Tsuria Col. 9 Lines 43-

55); and unscrambling the scrambled digital content by the end user device according to said permanent key, such that the end user device has permanent access to the scrambled digital content (See Tsuria Col. 9 Lines 6-15 and 43-55).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito. Saito disclosed sending the first set of information from the control center over network 8 (See Saito Col. 6 Lines 49-56) but failed to disclose that the first set of information included an address of the control center. It was well know in the art at the time of invention to include a source ip address in network communications in order to identify the source of a communication. It therefore would have been obvious to the ordinary person skilled in the art at the time of invention to include the address of the control center in the communication of the second key Ks2 to the end user. This would have been obvious because the ordinary person skilled in the art would have been motivated to identify the source of the communication.

Claims 109 rejected under 35 U.S.C. 103(a) as being unpatentable over Saito as applied to claim 106 above, and further in view of Tsuria. Saito disclosed providing a first information used in the decryption of the encrypted data (See Saito Col. 6 Lines 49-56) but failed to disclose

1 providing instructions to generate a code word and further using the code word to decrypt the
2 data. Tsuria teaches that in order to provide an encryption system with more flexibility to
3 upgrade the system, information for generating a code word should be provided in order to create
4 a code word then the code word should be used to decrypt the encrypted data (See Tsuria
5 Abstract). It would have been obvious to the ordinary person skilled in the art at the time of
6 invention to employ the teachings of Tsuria in the decryption system of Saito by providing
7 information to generate a code word to the end user and having the end user generate the code
8 word and use the code word to decrypt the data. This would have been obvious because Saito
9 would have been motivated to increase the flexibility to upgrade the system.

10 ***Conclusion***


11 Claims 84-122, 124-140, and 153-165 have been rejected.


12 Any inquiry concerning this communication or earlier communications from the
13 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.
14 The examiner can normally be reached on M-F 8-4.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
16 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the
17 organization where this application or proceeding is assigned is 571-273-8300.

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1 Information regarding the status of an application may be obtained from the Patent
2 Application Information Retrieval (PAIR) system. Status information for published applications
3 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
4 applications is available through Private PAIR only. For more information about the PAIR
5 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
6 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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14 Art Unit 2131
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